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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of : Confirmation No. 6456
Stephen GOLD et al. :
Serial No.: 09/826,811 : Art Unit: 2172
Filed: April 6, 2001 : Examiner: Baoquoc N. To
For: QUOTA MANAGEMENT IN CLIENT SIDE DATA STORAGE BACK-UP :

NOTICE OF APPEAL FROM THE PRIMARY EXAMINER
TO THE BOARD OF APPEALS AND STATEMENT REGARDING EXTENSION FEE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

May 12, 2004

Sir:

Applicants hereby appeal to the Board of Appeals from the decision of the Primary Examiner finally rejecting claims 21-47. Authorization for payment of the \$330 appeal fee is attached.

To the extent necessary, Applicants request an extension of time under 37 C.F.R. §1.136 in which to file this paper, and the Commissioner is hereby authorized to charge any required fees to counsel's Deposit Account No. 07-1337. However, **no extension fee should be required** as explained below:

- The USPTO mailed a final rejection on November 19, 2003.
- Applicants filed a responsive Amendment on Tuesday, January 20, 2004 (Monday, January 19, being a federal holiday), i.e., two months after the mailing date of the final rejection.

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- An Advisory Action was issued on February 9, 2004, stating that the Amendment would not be entered on the grounds it raised new issues that would require further consideration and/or search.
- On February 19, 2004, Applicants filed a Petition requesting entry of the Amendment, pointing out that the changes to the claims were for clarity or addressed minor informalities regarding antecedent basis. No substantive amendments were presented.
- When Applicants did not receive a Decision on Petition, counsel's staff telephoned Examiner To on March 3, 2004. Examiner To returned the call on March 8, 2004, stating that the Petition had been forwarded to Supervisory Primary Examiner Vincent Trans for review. Examiner To said he would monitor the case and keep counsel informed. Examiner To instructed counsel's staff to telephone him if they did not hear from him by Friday, March 12, 2004.
- In the absence of a Decision on Petition or telephone call from Examiner To, counsel's staff left telephone messages for him on Friday, March 12, 2004, and on Monday, March 15, 2004. Counsel's staff then called Examiner Trans, and left voicemail messages. Examiner Trans telephoned counsel's staff on April 3, 2004, and left a voicemail message that the Amendment would be entered and a communication to that effect would be issued.
- When counsel did not receive the promised communication, his staff telephoned Examiner Trans on April 12, April 16, and April 19, 2004, on which date an entry appeared in PAIR that an Advisory Action was mailed on April 16, 2004.
- On April 19, 2004, counsel's staff telephoned Examiner Laufer, one of the contacts given in Examiner Trans' voicemail greeting to call in an emergency. Examiner Laufer returned the call that afternoon. He said he could not comment on the contents of the Advisory Action, because the file was already in transit back to storage. However, Examiner Laufer assured counsel's staff that under PTO rules regarding extension fees after final rejection, Applicants would incur no extension fees even if they take no further action until the six-month date because the Amendment of January 20 was filed by the two-month date.
- Upon receiving the April 16 Advisory Action from the Assignee, counsel noticed that it did not indicate whether the Amendment filed January 20 was entered. Accordingly, counsel's staff placed several calls to Examiner To, as

well as to his former supervisor, who said the Amendment would **not** be entered and that Applicants would **not** have to pay extension fees.

- Seeking a second opinion, counsel's staff finally reached Examiner To on April 27, 2004. After checking with Examiner Trans, Examiner To then faxed counsel a revised Advisory Action summary page, confirming that the Amendment filed January 20, 2004, will be entered for purposes of appeal.

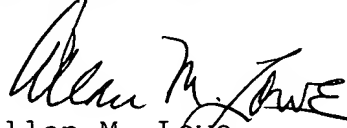
The MPEP provides for a shortened statutory period for replying to final actions. In the event a first reply is filed within two months of the mailing date of a final action and an Advisory Action is not mailed until after the end of the three-month shortened statutory period, the shortened statutory period will expire on the date the Advisory Action is mailed, and **any extension fee will be calculated from the mailing date of the Advisory Action.**

Counsel could not take appropriate action (i.e., file a Notice of Appeal) without receiving an Advisory Action indicating that the Amendment filed January 20 would be entered upon the filing of an appeal. There was no basis for the Examiner not to enter the Amendment in the first Advisory Action, and it would be profoundly unfair to force Applicants to file a Request for Continued Examination and pay the \$770 fee for filing an RCE in order to correct antecedent basis. Counsel and his staff diligently pursued an answer and outcome with four different USPTO employees, but still did not obtain a response until April 27, 2004 (and, it is noted, no Decision on Petition was ever received). In view of the foregoing, it is respectfully

submitted that Applicants should not be charged for a three-month extension of time, and confirmation that they will not be so assessed is respectfully requested.

Respectfully submitted,

LOWE HAUPTMAN GILMAN & BERNER, LLP

A handwritten signature in dark ink, appearing to read "Allan M. Lowe", is written over the typed name.

Allan M. Lowe
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